

Application No.: 09/867920

Docket No.: SMQ-052 (P5699)

**REMARKS**

Claims 1-24 are presently pending in the application of which claims 1, 12, 18 and 22 are independent.

**Claim Rejections Pursuant to 35 U.S.C. §103(a)**

Claims 1 and 3-10 were rejected by the Examiner pursuant to 35 U.S.C. §103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick (hereafter "Special Edition") in view of United States Patent No.: 6, 643, 694 to Chernin (hereafter "Chernin"). For the reasons set forth below, those rejections are respectfully traversed.

**Summary of Claimed Invention**

The claimed invention uses a search feature working with an email application to retrieve data from stored email messages. The search feature accepts a user-input search parameter. The search covers a current user-viewed storage location, and may also cover other email message storage locations as well. The search feature uses the parameter to retrieve data from email messages. The responsive data matching the search parameter is retrieved and a new document containing the responsive data is created.

**Summary of Special Edition**

The cited section of the Special Edition reference discusses finding and organizing OUTLOOK items. In response to user input search parameters, the Advanced Find feature displays search results to a user in a table format in the bottom of the search window. Searchable items include files, contacts, appointments, messages, notes and tasks. The search results point to the actual data indicated by the search. The search results may be double clicked by a user to display the item in the OUTLOOK form in which the item was originally created.

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Summary of Chernin

Chernin discusses a system and method for integrating a proxy server, an e-mail server and a DHCP server with a graphic interface. The system includes numerous subsystems such as a subsystem which allows email searching via a graphic interface, a subsystem to provide Internet access monitoring via a graphic interface and a subsystem adapted to configure a DHCP server via a graphic user interface. The email searching subsystem allows the searching of email text. The system allows the user to enter a text string through the graphic interface to be searched. The search feature in the subsystem then searches through email archives for the text string and displays the results to the user via the graphic interface.

Argument

The combination of Special Edition in view of Chernin fails to teach or suggest all of the elements of Applicant's independent claim 1 (and therefore also fails to teach or suggest all of the elements of claims 3-10 which are dependent thereon). Claim 1 includes the steps of retrieving data indicated by the [user-input] parameter from selected email messages in the active storage location and the step of creating a new document containing the data retrieved from the messages. Neither reference teaches or suggests these two steps.

The Examiner indicates Special Edition fails to teach the steps of retrieving data indicated by the user-input parameter from selected email messages in the active storage location and the step of creating a new document containing the data retrieved from the messages (see Office Action bottom of page 2 continuing to top of page 3) and instead relies on Chernin for the teaching of those claim elements. Applicant respectfully suggests that the Examiner's reliance on Chernin is misplaced in regards to the step of creating a new document containing the data retrieved from the messages.

The Examiner cited column 34 in Chernin as disclosing the final step in claim 1 that is missing from Special Edition. However, column 34 in Chernin does not teach or suggest the step of creating a new document containing the data retrieved from the messages (one of the

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claim limitations that the Examiner acknowledges is missing from Special Edition). The cited column 34 in Chernin indicates that the activation of the email search subsystem causes an email search display to be generated on the screen of the computer where the web browser was accessed (col. 34, lines 4-14). The search display accepts an input text string from the user and other parameters limiting the scope of the search. Following the user input the email search feature searches the email archives of the email server for the desired string of text, through the specified fields of the email messages, in accordance with the specified parameters (see col. 34, lines 56-64). When the search is complete, the results are displayed on the email searching display below the "Search type", "Search params" and Search Info fields as depicted in Figure 35 (see col. 34, lines 64 – col 35, line 1). Chernin does not teach or suggest the creation of new documents but rather inserts the search result excerpts into an existing display. This is not the creation of a new document required by Applicant's independent claim 1.

Accordingly, since the cited combination of references fails to teach or suggest all of the elements of Applicant's independent claim 1, Applicant respectfully requests the withdrawal of the pending rejection and the allowance of independent claim 1 and dependent claims 3-10 which are dependent upon claim 1 and include all of its elements.

Claim 2 was rejected by the Examiner pursuant to 35 U.S.C. §103(a) as being unpatentable over Special Edition in view of Chernin in further view of U.S. Patent Application No.: 2003/0163468 to Freeman et al (hereafter "Freeman"). For the reasons set forth below, this rejection is respectfully traversed.

Claim 2 is dependent upon independent claim 1 and includes the additional step of forwarding the newly created document to the user. The Examiner cites Freeman as teaching a document stream operating system which teaches the forwarding of the new document to a user of the electronic device. Freeman however does not supply the missing step of claim 1 discussed above however, namely the step of creating a new document containing the data retrieved from the messages. Since claim 2 includes all of the limitations of claim 1 and since the cited combination of references fails to teach or suggest all of the claim elements, Applicant respectfully requests the rejection be withdrawn.

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Claim 11 was rejected by the Examiner pursuant to 35 U.S.C. §103(a) as being unpatentable over Special Edition in view of Chernin in further view of U.S. Patent No.: 5, 634, 124 to Khoyi et al (hereafter "Khoyi"). For the reasons set forth below, this rejection is respectfully traversed.

Claim 11 is directly dependent upon claim 3 and indirectly dependent upon independent claim 1 and therefore includes all of the limitations of both claims. Claim 11 includes the additional element of forwarding the new document to a user after deleting email data that is duplicative. Claim 3 included the additional element of searching all of the email storage locations. As discussed above, Applicant believes both claims 1 and 3 to be in condition for allowance based on the arguments offered above. Applicant also respectfully disagrees with the Examiner's interpretation of Khoyi. The Examiner cites Khoyi as teaching data integration by object management and the forwarding of a new document to a user after deleting email that is duplicative and cites col. 40, lines 8-30 as support. The cited section of Khoyi discusses the copying, sharing and moving of data between objects in an object management system and does not discuss either the removing of email data that is duplicative in a document or documents in general. Accordingly since Khoyi does not teach or suggest the claim elements of claim 11 and since it does not provide the missing claim limitations from the combination of Special Edition and Chernin discussed above, Applicants request the withdrawal of the rejection and the allowance of the claim.

Claims 12-13, 15 and 18-19 were rejected by the Examiner pursuant to 35 U.S.C. §103(a) as being unpatentable over Special Edition in view of United States Patent No.: 6, 718, 518 to Plow et al (hereafter "Plow") in further view of United States Patent No.: 6, 216, 122 to Elson (hereafter "Elson"). For the reasons set forth below, those rejections are respectfully traversed.

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Summary of Plow

Plow discusses a system and method for displaying the results of a search. The patent discusses the use of dual windows with the first window displaying a selection of text in a document associated with an application. The user interacts with the application to institute a search within the first document and displays the results in a second window with the first window continuing to display the first set of text. The user is able to view one or more portions of a document containing specified search strings while continuing to view the first window where reading and/or editing is occurring. The user can also display search results from files or documents that are different from the first document.

Argument

The Examiner cites Plow as teaching the steps in Applicant's independent claim 12 of "searching said storage locations with said search feature, said search feature copying less than all the data in a selected email message containing data referenced by said parameter;" and "inserting the copied data from said selected email message and a hyperlink to said selected email message into a new document." The Examiner also feels that Plow teaches the steps in Applicant's independent claim 18 of "searching said storage locations with said search feature, said search feature copying less than all the data in a selected email message containing data referenced by said parameter;" and "inserting the copied data from said selected email message into a new document." The Examiner admits these steps are not found in Special Edition but states they are found in Plow. Applicant respectfully disagrees that the missing limitations are found in Plow.

The Examiner cites col. 6, lines 50-67 as teaching the claim limitations in independent Claims 12 and 18 that the Examiner admits are not found in Special Edition. The cited section discusses the use of a drop down list to provide a listing of files in which a previously entered search parameter may be found. A portion of the document displaying the usage of the search term in the active member of the drop down list is displayed in the search area of the user interface. Applicant respectfully suggests that the cited section does not teach the creation of a

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new document as required by claims 12 and 18 and does not teach or suggest the hyperlink limitation in claim 12.

The Examiner cites Elson for teaching an electronic mail indexing folder having a search scope and interval. The Examiner relies on Elson as disclosing a plurality of storage locations as required by claims 12 and 18. However, Elson does not teach or suggest the limitations missing from the combination of Special Edition and Plow which were discussed above. Accordingly, Applicant requests the withdrawal of the rejections directed to claims 12 and 18 and their allowance.

Claims 13 and 15, which are dependent upon independent claim 12, and claim 19, which is dependent upon independent claim 18 were rejected by the Examiner based on the Examiner's position that the claim limitations were taught by Special Edition. However, as set forth above, the combination of Special Edition, Plow and Elson fails to teach or suggest all of the limitations of claims 12 and 18. Accordingly, Applicant requests the withdrawal of the rejections directed to claims 13, 15 and 19 and their allowance.

Claims 14, 16 and 20 were rejected by the Examiner pursuant to 35 U.S.C. §103(a) as being unpatentable over Special Edition in view of Plow in further view of Elson and further in view of Chernin. For the reasons set forth below, those rejections are respectfully traversed.

Chernin was cited by the Examiner as teaching a new HTML document (claims 14 and 20) and Special Edition as teaching a search feature in a stand-alone application (claim 16). As previously noted however, the combination of references relied upon by the Examiner for the underlying independent claims 12 and 18 fails to teach or suggest all of the limitations in Applicant's claims. Applicant has also argued above that Chernin does not teach or suggest a new HTML document but rather an insertion of text into an existing document. Accordingly, Applicant requests the withdrawal of the rejections directed to claims 14, 16 and 20 and their allowance.

Claims 17 and 21 were rejected by the Examiner pursuant to 35 U.S.C. §103(a) as being unpatentable over Special Edition in view of Plow in further view of Elson and further in view

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of Khoyi. Applicant reasserts his previous arguments regarding the combination of references relied upon by the Examiner for rejecting the underlying independent claims 12 and 18 and respectfully suggests the combination fails to teach all of elements of the independent claims. Applicant further reasserts his previous arguments regarding Khoyi failing to disclose the step of deleting duplicative data from a document as required by claims 17 and 21. Accordingly, Applicant requests the withdrawal of the rejections directed to claims 17 and 21 and their allowance.

Claims 22-24 were rejected by the Examiner pursuant to 35 U.S.C. §103(a) as being unpatentable over Special Edition in view of Elson in further view of U.S. Patent No.: 5, 915, 249 to Spencer (hereafter "Spencer"). For the reasons set forth below, this rejection is respectfully traversed.

Independent claim 22 upon which claims 23 and 24 are dependent, include the steps of "inserting the copied data from said selected email message into a new document", "caching a copy of said new document"; and "cross-referencing said new document copy and said search request in an index of cached documents." The Examiner cited Special Edition as teaching the insertion of the copied data into a new document. Applicant respectfully suggests that Special Edition fails to teach or suggest the copying of data into a new document, but rather displays a table of search results on an existing graphic interface (See page 5 of Special Edition). Applicants also note that the Examiner's characterization of Special Edition as teaching the insertion of the copied data into a new document appears to be inconsistent with the Examiner's statement regarding claim 1 in which the Examiner stated that "Special Edition Using Microsoft Outlook 2000 fails to teach retrieving data indicated by said parameter from selected email messages in said active storage location; and creating a new document containing data retrieved from said messages"(see Office Action page 2-3).

The Examiner cites Spencer as teaching the steps of caching a copy of the new document and cross-referencing the new document copy and the search request in an index of cached documents. Spencer discusses a system and method for accelerated query evaluation of very large full-text databases and does discuss the caching of documents and their subsequent cross-reference with a query request. However, Spencer does not teach the insertion of copied data

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from the selected email message into a new document as required by independent claim 22, and, as mentioned above, that aspect is missing from the Examiner-relied upon Special Edition. The combination of Special Edition, Elson and Plow thus fails to teach all of the elements of independent claim 22 (as well as claims 23 and 24 which are dependent thereon). Accordingly, Applicant request the withdrawal of the rejections directed to claims 22-24 and their allowance.



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**CONCLUSION**

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this statement. However, if a fee is due, please charge our Deposit Account No. 12-0080, under Order No. SMQ-052 from which the undersigned is authorized to draw.

Dated: December 8, 2004

Respectfully submitted,

By 

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